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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,999	09/12/2003	Scott Trees	BAL6019P0022US	6084

32116 7590 07/15/2005

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 W. MADISON STREET
SUITE 3800
CHICAGO, IL 60661

EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,999

Applicant(s)

TREES ET AL.

Examiner

S. B. McCormick-Ewoldt

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-64, 70-73, 80 and 81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-64, 70-73, 80-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1655

DETAILED ACTION

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 28, 2005 has been entered.

Status of Application

The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1655.

Claims Pending

Applicant has cancelled claims 1-61, 65-69, 74-79 and 82-86. Claims 62-64, 70-73 and 80-81 will be examined on the merits.

Drawings

Applicant will petition for color photographs as acceptable drawings under 37 CFR 1.17(h) upon allowance of the claims.

Claim Rejections- 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62-64, 70-73, 80-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosner in view of Datta, Broertjes *et al* and Sharova *et al*. as previously stated in the prior Office action.

Cosner teaches New Guinea impatiens having striped flowers. Cosner also teaches that x-rays and chemical mutagens have been used to produce sports, but does not teach the methods for doing so (col. 2, line 56).

Datta discloses the use of gamma rays for changing the flower color; in particular, some cultivars show the petals having striped petals. (See examples on page 57, last paragraph; page 65, 3rd paragraph; page 68, 4th paragraph; page 69 last paragraph; page 170, last paragraph and page 174, various cultivars under "Rose".)

Broertjes *et al*. disclose production of petals that are striped in many different plants (dahlia on pg. 84 'Altamira'- orange and red strips; alstroemaria on pg. 154 'Zebra Stazeb'- heavily striped flower; carnation on pg. 159, 'Sim Feu Follet'- large yellow flower with broad red flowers.). See Chapter 5.

Sharova *et al*. disclose using chemical mutagens in addition to irradiation to cause "petal mottling" in balsam (see page 9, 3rd paragraph and Table 2). Balsam is in the *Balsaminacea* family that also includes the New Guinea impatiens that has been developed from species of *Impatiens hawkeri*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to subject New Guinea Impatiens to irradiation and/or chemical mutagenesis as taught by Datta, Broertjes and Sharova, with the motivation being to obtain an easily applicable, clean method with good penetration of reproducibility, high mutation frequency and large economic importance to the horticulture industry (Broertjes page 12-13), to produce new New Guinea Impatiens varieties having novel characteristics such as the striped petals disclosed by Cosner. There would have been a reasonable expectation of success, because it was already known that striped petals could be produced in impatiens as shown in Cosner and Sharova. Thus the invention as a whole was clearly *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant argues the Datta, Broertjes and Sharova references all teach using the claimed invention on plants other than New Guinea impatiens plants. This is not persuasive, as Applicant has not explained why the methods in the prior art would not be expected to work with New Guinea impatiens plants. The mode of action (mutation) is the same, alteration of DNA at chromosome level and Cosner states that the method is “typically used” (column 2, line 56).

Applicant argues that Cosner teaches away from Applicant’s claimed invention. This is not persuasive as mutagenesis is a quick way to introduce the striping trait into an “elite” variety that does not have this trait in its genetic background already.

Cosner basically teaches breeding and selection methods for populations of plants that have the striped trait in their genetic background.

Crossing one of Cosner’s plants with an elite variety (elite=a variety with lots desirable traits) will alter lots of traits besides flower color. It would take several generations of back crossing to get the elite variety with only the flower color changed. In contrast, mutagenesis of an elite variety allows one to quickly select new varieties that have the altered flower color but retains all the other desirable traits of the elite variety. So there is motivation to use the mutagenesis method. Another motivation might simply be that one does not have ready access to Cosner’s plants.

For the reasons discussed above and in the previous action, the rejections are deemed proper and are maintained.

Summary

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1655

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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